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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/754,463	01/04/2001	Akira Arai	9319A-000183	3626

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Harness, Dickey & Pierce, P.L.C.  
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EXAMINER

SHEEHAN, JOHN P

ART UNIT

PAPER NUMBER

1742

DATE MAILED: 08/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application N .

09/754,463

Applicant(s)

ARAI ET AL.

Examiner

John P. Sheehan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondenc address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5 and 7-22 is/are pending in the application.
- 4a) Of the above claim(s) 11-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5 and 7-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other:

## **DETAILED ACTION**

### ***Election/Restrictions***

1. This application contains claims 11-22 drawn to an invention nonelected with traverse in Paper No. 8. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1 to 3, 5 and 7 to 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over each of Panchanathan (Panchanathan, US Patent No. 5,72,792, cited by the applicants in the IDS submitted January 4, 2001).

Panchanathan teaches a magnetic powder having a composition that overlaps the alloy composition recited in the instant claims (Panchanathan, column 1, lines 37 to 50). Panchanathan also teaches a process of making the disclosed magnetic powder that is similar to, if not the same as, the process disclosed in the instant application (Panchanathan, column 2, lines 1-21). Panchanathan teaches the presence of a hard and soft magnetic phase (column 1, lines 50 to 57). The composition of

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Panchanathan's Example N (column 3) is based on weight percent (column 1, lines 32 to 33) when converted to atomic percent (assuming that the atomic weight of the rare earth component is 144) has the composition:

Rare earth	7.6 atomic %
Boron	5.9 atomic %
Niobium	1.2 atomic % and
Iron	the balance.

Panchanathan discloses that the coercivity of Example N is 5.07 kOe or 399.5 kA/m.

These proportions and coercivity for Panchanathan's Example N are completely encompassed by the instant claims.

The claims and Panchanathan differ in that Panchanathan is silent with respect to the soft phase being constrained through the surrounding hard magnetic phase and the irreversible susceptibility.

However, one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because the alloy taught by Panchanathan has a composition that overlaps the alloy composition recited in the instant claims and therefore is considered to establish a prima facie case of obviousness, *In re Malagari*, 182 USPQ 549 and MPEP 2144.05. Further, in view of the fact that the alloy taught by Panchanathan is made by a process which is similar to, if not the same as, applicants' process of making the instantly claimed alloy, the alloy taught by the reference would be expected to possess all the same properties as recited in the instant claims, *In re Best*, 195 USPQ, 430 and MPEP 2112.01.

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“Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established, In re Best, 195 USPQ 430, 433 (CCPA 1977). ‘When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.’ In re Spada, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Therefore, the prima facie case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product. In re Best, 195 USPQ 430, 433 (CCPA 1977).” see MPEP2112.01.

This is considered to be particularly true in view of the fact that the composition and coercivity of Panchanathan’s Example N alloy are encompassed by the instant claims and is made by a process which is similar to, if not the same as, applicants’ process of making the instantly claimed alloy, the alloy taught by Panchanathan would be expected to possess all the same properties as recited in the instant claims, In re Best, 195 USPQ, 430 and MPEP 2112.01.

**NOTE:** The above rejection based on Panchanathan was first made in the Office action mailed February 26, 2002. This rejection was withdrawn based on applicants’ argument that the B content of Panchanathan’s Example N was only 1.07 % while the instant claims require 4.6 to 6.9 % B. However, applicants’ claims are directed to atomic percents while the proportions of Panchanathan’s Example N are in weight percent. Thus, a direct comparison between Panchanathan’s proportions and the instantly claimed proportions is not proper. In view of this the Examiner has reinstated the rejection based on Panchanathan.

### ***Response to Arguments***

1. Applicant's arguments filed June 12, 2003 have been fully considered but they are not persuasive.

Applicants compare Sample 4 in Table 1 of the instant specification to Panchanathan's Example N and point out that although both of these alloys contain 1.2 atomic % Nb, applicants' alloy attains a coercivity of 496 kA/m while Panchanathan's alloy achieves a coercivity of 399.5 kA/m and in that view of this difference in coercivity applicants "assert that the products of Panchanathan do not possess the characteristics of the claimed invention, and therefore, the claimed invention is not obvious." The Examiner is not persuaded. Although Panchanathan's Example N and applicants' Sample 4 in Table 1 contain the same amount of Nb, these alloys differ in every other aspect of their compositions. Thus, any difference in properties may not be that "the products of Panchanathan do not possess the characteristics of the claimed invention" but rather applicants are attempting to compare two totally different alloy compositions that are encompassed by the instant claims and since they are different compositions one would expect that their properties would be different. As set forth in the statement of the rejection the proportions and coercivity of Panchanathan's Example N are completely encompassed by the instant claims.

### ***Conclusion***

2. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

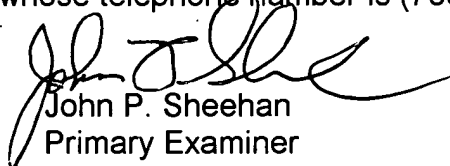
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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Sheehan whose telephone number is (703) 308-3861. The examiner can normally be reached on T-F (6:30-5:00) Second Monday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (703) 308-1146. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.

  
John P. Sheehan  
Primary Examiner  
Art Unit 1742

jps

August 17, 2003